UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* INTELLECTUAL VENTURES I LLC[1]

_____

Appeal 2017-000054
Application 14/295,636
Technology Center 2400

_____

Before LARRY J. HUME, JOHN P. PINKERTON, and
JOHN D. HAMANN, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final
Rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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## STATEMENT OF THE CASE[2]

### *The Invention*

Appellant's disclosed and claimed inventions "relate[] generally to computer systems and computer networks. In particular, the present disclosure relates to a system and method for detecting and nullifying the effects of computer viruses." Spec. ¶ 3.

### *Exemplary Claim*

Claim 1, reproduced below, is representative of the subject matter on appeal (*emphases* added to contested limitations):

> 1.    A method comprising:
>
> receiving, at a computing device, a message from an email server, wherein the received message includes a file comprising an executable code;
>
> *disconnecting the computing device from communication with the email server* after receiving the message from the email server;
>
> *executing the executable code at the computing device*;
>
> performing a check of the computing device to identify unexpected changes after executing the executable code;
>
> if the unexpected changes are identified, activating a virus alert and executing a ghost copy reboot of the computing device; and
>
> re-establishing a communication connection between the computing device and the email server.

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[2] Our decision relies upon Appellants' Appeal Brief ("App. Br.," filed Mar. 18, 2016); Reply Brief ("Reply Br.," filed Sept. 26, 2016); Response after Final Rejection ("Response," filed Nov. 23, 2015); Examiner's Answer ("Ans.," mailed July 27, 2016); Final Office Action ("Final Act.," mailed Sept. 23, 2015); and the original Specification ("Spec.," filed June 4, 2014).

*Prior Art*

The Examiner relies upon the following prior art as evidence in rejecting the claims on appeal:

Boccon-Gibod ("Boccon")    US 5,426,775    June 20, 1995

Chen et al. ("Chen")            US 5,832,208    Nov. 3, 1998

Buckley et al. ("Buckley")    US 6,035,327    Mar. 7, 2000

*Rejections on Appeal*

R1.    Claims 1–20 stand rejected under the judicially created ground of obviousness-type double patenting (OTDP) over: (a) claims 1–43 of U.S. Patent No. 6,901,519 B1; (b) claims 1–41 of U.S. Patent No. 7,506,155 B1; (c) claims 1–64 of U.S. Patent No. 7,913,078 B1; (d) claims 1–48 of U.S. Patent No. 7,979,691 B2; and (e) claims 1–37 of U.S. Patent No. 8,769,258 B2. Final Act. 4.

R2.    Claims 1–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Chen, Buckley, and Boccon. *Id.*

CLAIM GROUPING

We address OTDP Rejection R1 of claims 1–20, not argued separately or with specificity, *infra*. *See* Response 6.

Based on Appellants' arguments (App. Br. 9–14), we decide the appeal of obviousness Rejection R2 of claims 1–20 on the basis of representative claim 1.[3]

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[3] "Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together

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ISSUES AND ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellants. We do not consider arguments that Appellants could have made but chose not to make in the Briefs, and we deem any such arguments waived. 37 C.F.R. § 41.37(c)(1)(iv).

We disagree with Appellants' arguments with respect to claims 1–20, and we incorporate herein and adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2) the reasons and rebuttals set forth in the Examiner's Answer in response to Appellants' arguments. We incorporate such findings, reasons, and rebuttals herein by reference unless otherwise noted. However, we highlight and address specific findings and arguments regarding claim 1 for emphasis as follows.

1.  OTDP Rejection R1 of Claims 1–20

    *Issue 1*

    Did the Examiner err in rejecting claims 1–20 over the various claims of the patents identified by (a)–(d) in Rejection R1, *supra*?

    *Analysis*

    Appellants merely state,

    > Applicant respectfully requests that the present double patenting rejections be held in abeyance until such time as the pending claims of the present application are otherwise deemed to be in condition for allowance. At such time, Applicant will

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    shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R. § 41.37(c)(1)(iv).

review and respond as appropriate to the double patenting rejections, if still applicable.

Response 6.

In light of the lack of *any* specific or substantive argument to rebut Rejection R1 of claims 1–20, we *pro forma* sustain the rejection of these claims. Arguments not made are waived. 37 C.F.R. § 41.37(c)(1)(iv).

2.      § 103 Rejection R2 of Claims 1–20

*Issue 2*

Appellants argue (App. Br. 9–14; Reply Br. 4–8) the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being obvious over the combination of Chen, Buckley, and Boccon is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art combination teaches or suggests a method that includes, *inter alia*, the steps of "disconnecting the computing device from communication with the email server," and "executing the executable code at the computing device," as recited in claim 1?

*Analysis*

Appellants generally contend the cited prior art combination fails to teach or suggest the contested "executing" and "disconnecting" steps of claim 1. App. Br. 10, 13.

In particular, with respect to the recited "executing" step, Appellants argue Chen's teaching of scanning and removing detected viruses "is not analogous to 'executing the executable code' of the file." App. Br. 11 (emphasis omitted). Appellants further allege "Chen appears to *teach away*

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*from* executing the executable code of suspect file . . . [because] the goal of Chen is to <u>identify and remove</u> the viruses, not cause them to become active." *Id.* Additionally, Appellants contend the portion of Chen relied upon by the Examiner fails to provide any evidence of file execution at the computing device. *Id.* Further to this point, Appellants argue Chen, column 1, lines 26–34, "merely describes what a computer virus is . . . . [t]he fact that a virus is 'executable' or can possible [sic] execute itself is not the same as the claimed 'executing the executable code at the computing device.'" *Id.* (emphasis omitted). Appellants further argue:

> Nothing in this section cited by the Examiner provides any disclosure, suggestion, or teaching of the claimed 'executing the executable code at the computing device . . . . [and s]tating that a virus is 'executable' or that a macro virus can be run when a program document is accessed is not the same as what is claimed.

App. Br. 12 (emphasis omitted).

Our reviewing court guides, "[i]n the patentability context, claims are to be given their broadest reasonable interpretations . . . limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citations omitted). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998); *see also Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1381 (Fed. Cir. 2008) ("A patentee may act as its own lexicographer and assign to a term a unique definition that is different from its ordinary and customary meaning; however, a patentee must clearly express that intent in the written

description."). Absent an express intent to impart a novel meaning to a claim term, the words take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003) (citation omitted).

Appellants have not cited to a definition of **"executing** . . . executable code at the computing device" in the Specification that would preclude the Examiner's broader reading. Ans. 4.

We agree, because as the Examiner finds, Chen columns 1 through 3 teach or at least suggest that a virus is executable code which can be embedded in a macro of a specific computer program such as a word processing program further spread as an email attachment. Moreover, we note these portions of Chen cited by the Examiner ("Background of the Invention") provide background information regarding problems associated with viruses executing on unsuspecting computer systems, for which Chen's invention is intended to overcome. Thus, while Chen's ultimate goal is to preclude virus execution using Chen's claimed invention, we disagree with Appellants' contention that Chen's background does not teach or at least suggest a computing device executing code that includes a virus.

Appellants further argue Buckley does not teach or suggest the recited "disconnecting" step because the SMTP protocol for connections described therein teaches disconnecting communication between a sending server and a receiving server after an email message is transferred. App. Br. 13. Appellants attempt to distinguish the recited computing device which executes the executable code from Buckley's teaching of a server because

"[the] claimed this disconnection is not between sending and receiving _servers_." App. Br. 14.

We disagree with Appellants' argument because, under a broad but reasonable interpretation, the recited "computing device" reads on the disclosed server of Buckley.

Furthermore, we have reviewed Appellants' argument in the Reply Brief, and find they unpersuasively reiterate arguments presented in the Appeal Brief. Reply Br. 4–8.

Therefore, based upon the findings above, on this record, we are not persuaded of error in the Examiner's reliance on the combined teachings and suggestions of the cited prior art combination to teach or suggest the disputed limitation of claim 1, nor do we find error in the Examiner's resulting legal conclusion of obviousness. Therefore, we sustain the Examiner's obviousness rejection of independent claim 1, and grouped claims 2–20 which fall therewith. _See_ Claim Grouping, _supra_.

## REPLY BRIEF

To the extent Appellants may advance new arguments in the Reply Brief (Reply Br. 4–8) not in response to a shift in the Examiner's position in the Answer, we note arguments raised in a Reply Brief that were not raised in the Appeal Brief or are not responsive to arguments raised in the Examiner's Answer will not be considered except for good cause (_see_ 37 C.F.R. § 41.41(b)(2)), which Appellants have not shown.

## CONCLUSIONS

(1)    Appellants have not shown the Examiner erred with respect to OTDP Rejection R1 of claims 1–20, and we *pro forma* sustain the rejection.

(2)    The Examiner did not err with respect to obviousness Rejection R2 of claims 1–20 under 35 U.S.C. § 103(a) over the cited prior art combination of record, and we sustain the rejection.

## DECISION

We affirm the Examiner's decision rejecting claims 1–20.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See* 37 C.F.R. § 41.50(f).

## AFFIRMED